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JEFFER, MANGELS, BUTLER & MARMARO, LLP
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LOS ANGELES, CA 90067

EXAMINER

VAN, QUANG T

ART UNIT	PAPER NUMBER
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DATE MAILED: 12/05/2000

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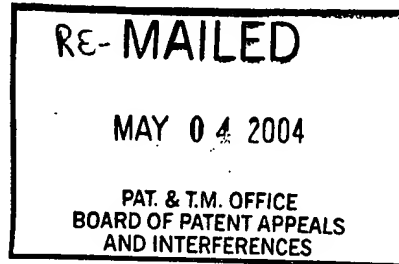
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BEFORE THE BOARD OF PATENT APPEALS
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Paper No. 22

Application Number: 09/739,990
Filing Date: December 18, 2000
Appellant(s): CHANG ET AL.

Rod S. Berman
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

In response to the paper of "REMAND TO THE EXAMINER", the examiner has prepared as follow:

1. The examiner is including the translation to the English Language version of Netherlands (patent No. 542,359) and the examiner is also including the translation of Patent of Taiwanese 040,687, which is provided by applicant. Further, the examiner

has obtained and relied upon the entirety of both translation documents to support the §103 rejection.

2. In response to the paragraph 6 of the "REMAND TO THE EXAMINER", the examiner has corrected to clarify the inconsistency assertion in the §103 rejection of claim 42.

3. In response to the paragraph 7 of the "REMAND TO THE EXAMINER", the examiner has corrected to indicate that the amendment filed on November 25, 2002, has been entered.

This is a supplemental response to the appeal brief filed November 25, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Claim 44 is the only claim in this appeal.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,142,123	Chou	8-1992
542,359	Netherlands	11-1955
040,687	Taiwanese	4-1988

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chou (US 5,142,123) in view of Netherlands (542,359) both cited by applicant, and further in view of Taiwanese (040,687). The following ground(s) of rejection are applicable to the appealed claim:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chou (US 5,142,123), in view of Patent Netherlands 542,359 (with the English translation) both cited by applicant and further in view of Patent Taiwanese 040,687 (applicant provided English translation) also cited by applicant. Chou'123 discloses an electric heat sealer comprising a housing (1), a press bar (2) pivotally connected to said housing (1), a heating unit (6) mounted a heat insulate base (63), the heat insulate base (63) mounted in said housing (1), a source of current (10), and circuitry electrically connection said heating unit and said source of current. However, Chou'123 does not disclose a heating unit mounted in said press bar and a free end of said press bar is pivoted downwardly said metal press plate causes said circuit to close, wherein said metal press plate is secured to said press bar. Netherland'542,359 shows an electric heat sealer having a heating unit (7, page 4, line 2 in the English translation version) mounted in said press bar (1, page 3, line 20 in the English translation version). Taiwanese'687 shows a free end of a press bar (20, page 5, line 10 in the English translation version) is pivoted downwardly a metal press plate (14, page 5, line 10 in the English translation version) causes said circuit (15, page 5, lines 22-25 in the English translation version) to close, wherein said metal press plate is secured to a base (10, page 5, line 10 in the English translation version). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Chou'123 a heating unit mounted in said press bar as taught by Netherlands'359 in order to provide heat directly to the object from the top, and a free end of said press bar is

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pivoted downwardly said metal press plate causes said circuit to close as taught by Taiwanese'687 in order to activate a heating mechanism. With regard to "said metal press plate is secured to said press bar", Taiwanese'687 only shows said metal press plate is secured to a base (10) instead of a press bar. It would have been obvious to one having ordinary skill in the art at the time the invention was made to secure a metal press plate to a press bar, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In Japikse*, 86 USPQ 70.

(11) Response to Argument

I. Appellant argues that "there is no motivation to combine contained in Chou'123, Netherlands'359 and Taiwanese'687" recited on page 6 of Brief of Appeal.

A. Taiwanese'687 disparaging alternating current (AC) power supplies.

The Applicant argues that Taiwanese'687 disparages sealers that are powered by AC power supplies, as the Netherlands'359 sealer is. The Taiwanese'687 and Netherlands'359 references are not cited for the type of their power supplies, but for the teaching of a heating unit mounted in a press bar and a free end of said press bar pivoting said metal press plate downwardly to cause a circuit to close. Additionally, Chou'123 discloses that an electric handheld heater can be powered by means of an AC or DC power supply (col. 1, lines 35-39), which provides support for using either type of the heater power supply.

B. Smaller sealer vs. larger sealer.

The Applicant argues that "one of the objectives that Taiwanese'687 attempts to achieve includes a smaller, portable design, which is opposite to what is taught by Netherlands'359". Sealers made by different brand names will have different sizes and their sizes also depend on the sizes of product they are intended to seal. Therefore, that Taiwanese'687 and Netherlands'359 sealers have different sizes is considered normal. Taiwanese'687 and Netherlands'359 are both in the electric heat sealers art; thus, they are considered to be analogous.

C. Metal press plate is secured to the press bar.

The appellant argues that Taiwanese'687 only shows the metal press plate is secured to a base, instead of a press bar. The Taiwanese'687 shows metal press plate 14 is secured to a base 10 (bottom). The metal press plate functions to disengage the switch and turn-off the heater when no pressure is acting on the press bar. Its function will perform the same whether it is mounted on the top (press bar) or in the bottom (the base). Therefore, the examiner considers that it is not patentable when a mechanical mounting piece is mounted in reverse and its function is performed exactly the same.

Further, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be

motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

II. Even assuming the combination of Chou'123, Netherlands'359 and Taiwanese'687 is proper, the combined references neither teach nor suggest the combination as taught by appellant.

The Applicant argues that "if the press plate is moved to another location, the function of the press plate would be changed from being biasing and a switch activation mechanism to being a biasing means only, and requiring another mechanism to activate the switch" and "the references, specifically Taiwanese'687, in fact teaches away from securing the metal press plate to the press bar as doing so would require that the wire connecting the metal press plate to the power source be extended so that it would still reach the metal press plate".

Taiwanese'687 only shows said metal press plate (14, page 5, line 10 in the English translation version) is secured to a base (10, page 5, line 10 in the

English translation version) instead of a press bar (20, page 5, line 10 in the English translation version). One having ordinary skill in the art would reverse the mounting to secure a metal press plate to a press bar, since it has been held that rearranging parts of an invention involves only routine skill in the art. Here, the rearranging parts means reverse mounting of the press plate. It only requires the re-positioning of the mechanical structure of the metal press plate (14) from the bottom (the base 10) to the top (the press bar 20); thus, it does not change any switching condition, its function is will perform the same whether the metal press plate is mounted on the top (press bar) or in the bottom (the base) and also does not require any extended electric wire. Therefore, one having ordinary skill in the art could select either mounting the metal press plate on the base or on the press bar would provide the heater with the same result. Therefore, claim 44 remain rejected under 35 U.S.C. 103(a).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



QV

December 2, 2003

Conferees

John Jeffery

Tu Hoang

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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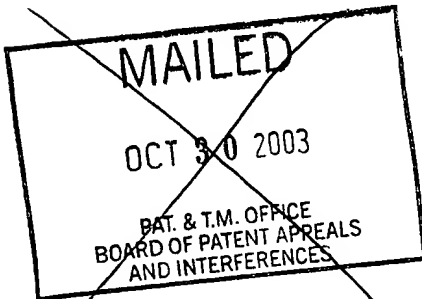
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PAT. & T.M. OFFICE
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Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RICHARD CHANG
and
AMMY CHOU

Appeal No. 2003-1229
Application 09/739,990

ON BRIEF

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR

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Application 09/739,990

§ 1.196(a) and MPEP § 1211 for appropriate action with regard to items indicated below.

1. On January 24, 2002, the examiner issued a final rejection (Paper No. 11) including a rejection of claim 44 under 35 U.S.C. § 103(a) based on Chou (US 5,142,123), Netherlands 542,359 and Taiwanese 040,687. Although the examiner appears to have relied upon the entirety of each of the applied foreign language documents to support the § 103 rejection, it appears from the record that the examiner did not have a translation of each of the foreign language documents.

2. Appellants filed a Notice of Appeal on July 24, 2002 (Paper No. 14). A Supplemental Amendment and Appeal Brief were filed on November 25, 2002 and collectively entered on the file jacket as Paper No. 16. An Examiner's Answer was mailed on January 8,

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2003 (Paper No. 17). A Reply Brief was subsequently filed by appellants on March 10, 2003 (Paper No. 18) and acknowledged by the examiner as being "entered and considered" (Paper No. 19).

3. The application was then forwarded to the Board of Patent Appeals and Interferences, where a Docketing Notice was mailed on May 1, 2003 (Paper No. 20).

4. However, we note that in April of 2002, Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, issued a memorandum addressing "Reliance upon abstracts and foreign language documents in support of a rejection." In that memo it is stated that "no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: 1) a rejection is supported in whole or part by an abstract without

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reference to the underlying document . . . or 2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English." The memo expressly indicates that an examiner relying on a document in a language other than English must obtain a translation so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection and that it should be a "rare occurrence" that an examiner's answer is prepared where a rejection is based upon an abstract rather than the underlying document.

5. Since we find no translations obtained by the examiner in the current record, it is unclear as to the precise facts the examiner is relying upon to support the rejection of claim 44 before us on appeal.

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Application 09/739,990

Accordingly, we REMAND the application to the examiner for clarification and to obtain appropriate translations of the foreign language documents relied upon.¹ As observed in the Memo from Deputy Commissioner Kunin, this will permit the examiner to consider the patentability of the claims in light of a fuller set of facts. The examiner's assessment of the full text documents (translations) in support of the rejection under 35 U.S.C. § 103(a) would appropriately be set forth in a supplemental answer, with appellants having the right to respond thereto.

¹ The examiner should note that what appears to be an English language version of Taiwanese 040,687 is attached to the copy of this foreign language document in the record. However, there is no indication that the examiner actually relied upon the English language version of the Taiwanese document. No translation of Netherlands 542,359 appears in the record.

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6. The examiner's assertion on page 5 of the answer that Netherlands '359 "only shows said metal press plate is secured to a base (10) instead of a press bar," appears to be inconsistent with the examiner's earlier finding near the top of page 5 that it is Taiwanese '687 which shows a metal press plate (14) secured to a base (10). Clarification is required.

7. In addition to the foregoing, it does not appear from the record that the examiner has provided any indication to appellants concerning entry or non-entry of the amendment filed on November 25, 2002, or made a notation on the amendment itself concerning entry/non-entry thereof. Thus, we also REMAND for correction of this oversight as well.

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Aug. 2001. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.


REMAND TO THE EXAMINER

Charles E. Frankfurt

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB

LAWRENCE J. STAAB
Administrative Patent Judge


JENNIFER D. BAHR

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2003-1229
Application 09/739,990

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